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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/989,727   | 11/19/2001  | Audrey Goddard       | P2730P1C65          | 2390             |
| 35489  | 7590        | 04/10/2006           | EXAMINER            |                  |
| HELLER EHRMAN LLP<br>275 MIDDLEFIELD ROAD<br>MENLO PARK, CA 94025-3506 |             |                      | ROMEO, DAVID S      |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 1647                |                  |
| DATE MAILED: 04/10/2006  |             |                      |                     |                  |

Please find below and/or attached an Office communication concerning this application or proceeding.

|   |                                      |                                       |  |
|---|--------------------------------------|---------------------------------------|--|
| <b>Advisory Action</b><br><b>Before the Filing of an Appeal Brief</b> | <b>Application No.</b><br>09/989,727 | <b>Applicant(s)</b><br>GODDARD ET AL. |  |
|   | <b>Examiner</b><br>David S. Romeo    | <b>Art Unit</b><br>1647               |  |

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 10 March 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

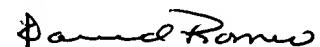
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: \_\_\_\_\_.
- Claim(s) objected to: 136 and 138.
- Claim(s) rejected: 124-126, 129, 135 and 137.
- Claim(s) withdrawn from consideration: \_\_\_\_\_.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_
13. ☒ Other: See Continuation Sheet.

  
 David S. Romeo  
 Primary Examiner  
 Art Unit: 1647

Continuation of 3. NOTE: The after final will not be entered because they raise new issues that would require further consideration and/or search and/or new rejections citing new art. For example, the examiner would have to consider the misidentified nucleotides, insertions or deletions of nucleotides in the Incyte EST sequence as compared to DNA56748 in Exhibit A, and cite new art regarding the fact that DNA sequences generated by sequencing reactions can contain sequencing errors. The errors exist as misidentified nucleotides, or as insertions or deletions of nucleotides in the generated DNA sequence, even though the generated DNA sequence may be identical to the actual DNA sequence.

Continuation of 11. does NOT place the application in condition for allowance because: Applicants' arguments have been fully considered but they are not persuasive. The declaration of Dr. William Wood filed 03/10/2006 has not been entered. Applicants argue that "the Incyte EST 3476792 sequence, only disclosed an incomplete DNA sequence ... " or "the Incyte EST sequence did not code for the full-length PRO1186 polypeptide ... " In Example 118 the specification states: "... the Incyte EST clone 3476792 was purchased and the cDNA insert was obtained and sequenced. It was found that this insert encoded a full-length protein. The sequence of this cDNA insert is shown in FIG. 265 and is herein designated as DNA60621-1516." However, a DNA "sequence" is merely descriptive of the linear order of monomers of which a DNA molecule/clone/insert/cDNA is made and is not a DNA molecule/clone/insert/cDNA. From the evidence provided it cannot be determined if the Incyte EST sequence referred to by Applicants is a partial sequence of the Incyte DNA molecule/clone/insert/cDNA or if it is the complete and entire sequence of the Incyte DNA molecule/clone/insert/cDNA. Therefore, it is appropriate to maintain the rejection.

In view of the withdrawal of claims 13-25 of copending Application No. 10/692,299, the provisional rejection under the judicially created doctrine of obviousness-type double patenting has been withdrawn. As a result, claims 136 and 138 are objected to as being dependent upon a rejected base claim.

Continuation of 13. Other: In view of the papers filed 01/24/2006, the inventorship in this nonprovisional application has been changed by the deletion of Avi J. Ashkenazi, Kevin P. Baker, David Botstein, Luc Desnoyers, Dan L. Eaton, Napoleone Ferrara, Sherman Fong, Hanspeter Gerber, Mary E. Gerritsen, J. Christopher Grimaldi, Ivar J. Kijavin, Mary A. Napier, James Pan, Nicholas F. Paoni, Timothy A. Stewart, Daniel Tumas, P. Mickey Williams, Margaret Roy and Zemin Zhang.